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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) : Erik Romanski et al.
U.S. Serial No. : 09/923,936
Filed : August 7, 2001
For : **FLOTATION COATING FOR WATER TRANSPORT
BAGS**
Examiner : Andrew D. Wright
Group Art Unit : 3617
Confirmation No. : 5169

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Ronald R. Santucci, Reg. No. 28,988

(Name of Applicant, Assignee or Registered Representative)

Ronald R. Santucci
signature

November 18, 2005

Date of Signature

SECOND REVISED APPEAL BRIEF OF APPELLANT

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Sir:

This second revised appeal brief is submitted in response to the Notice of Non-Compliant Appeal Brief issued by Examiner Wright on November 8, 2005. This is an Appeal from the Final Rejection by the Examiner dated May 28, 2004, which issued in the above-identified application, finally rejecting claims 1-3. A Notice of Appeal was filed on September 28, 2004. This Brief is submitted in accordance with 37 C.F.R. §41.37. The Assistant Commissioner is

authorized to charge any additional fee, or credit any overpayment, to Deposit Account No. 50-0320.

REAL PARTY IN INTEREST

The real party in interest is Albany International Corp., 1373 Broadway, Albany, NY 12204, to which Appellant has assigned all interest in this application.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

The Application was filed with claims 1-11 on August 7, 2001, and assigned Application Serial No. 09/923,936. This application is a continuation-in-part of U.S. Serial No. 09/907,877 filed July 18, 2001, which in turn is a continuation-in-part of U.S. Serial No. 09/832,739 filed April 11, 2001.

In a preliminary amendment dated March 20, 2002 Appellant filed a preliminary amendment adding new claims 12 and 13.

In an official communication dated September 23, 2003, the Examiner issued a restriction requirement, requesting Appellant to select an embodiment for further prosecution on the merits.

In response to the restriction requirement, Appellants amended the claims to depend from a generic claim 1. In addition, Appellants provisionally elected 1-4 for further prosecution on the merits.

The Examiner issued an Office Action on December 1, 2003. In the Office Action, the Examiner issued an Examiner's amendment to claim 1, and because there was allegedly no

allowable generic claim, forced the withdrawal of claims 5-13 from further consideration on the merits. The Examiner rejected claims 1, 3, and 4 under 35 U.S.C. § 112, second paragraph, on indefiniteness and insufficient antecedent basis grounds. The Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. 3,779,196 to Knaus et al. The Examiner also rejected claims 3 and 4 under 35 U.S.C. § 103(a) as unpatentable over Knaus et al. in view of U.S. Patent No. 2,391,926 to Scott.

In response to the Office Action Appellants submitted a response on February 27, 2004, in which claims 1-5, 8, and 11 were amended to overcome the rejections under 35 U.S.C. § 112. Appellants traversed the Examiner's rejections under 35 U.S.C. §§ 102 and 103.

The Examiner then issued a Final Office Action on May 28, 2004. The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 2,997,973 to Hawthorne et al. in view of U.S. Patent No. 4,897,303 to McCullough, Jr. et al.

A response to the Final Office Action was filed by Appellants on August 27, 2004 traversing the Examiner's rejection of claims 1-3.

A Notice of Appeal was filed by Appellant on September 28, 2004, from which this Appeal Brief is being filed.

The Examiner issued an Advisory Action on October 18, 2004, maintaining the rejections recited in the Final Office Action.

An interview was conducted with the Examiner on December 14, 2004, however no agreement was reached regarding the rejected claims.

The Examiner issued an interview summary on December 17, 2004, again maintaining the rejections of the Final Office Action.

Accordingly, the status of the claims may be summarized as follows:

Claims Allowed: None.
Claims Objected to: 4.
Claims Rejected: 1-3
ClaimsAppealed: 1-3
Claims Withdrawn: 5-13.

STATUS OF THE AMENDMENTS

Appellant believes that all the submitted Amendments have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The citations to Figures and Specification locations are provided immediately following elements of independent claim 1, which is summarized below. However, such citations are provided merely as examples and are not intended to limit the interpretation of the claims or to evidence or create any estoppel.

Claim 1, the only independent claim at issue in this appeal is directed to a flexible fluid containment vessel (Fig. 1, 10) for the transportation and/or containment of cargo comprising a fluid or fluidisable material (p.5, ll. 27-32). The vessel (Fig. 1, 10) includes an elongated flexible tubular structure (Fig. 1, 12) comprised of fabric having a first side (Fig. 2, 26) and a second side (Fig. 2, 30). The tubular structure is impervious (p. 16, ll6-12) and has a front end and a rear end (See, Fig.1). The vessel also includes means for sealing said front end and said rear end (p.10, ll. 31-32), means for filling and emptying (See Claim 1 as originally filed) said vessel of cargo; and means (p. 18, ll. 6-9) for rendering said tubular structure buoyant comprising forming said fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant (p.12, l. 26-p. 14, l. 18).

GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3 have been rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 2,997,973 to Hawthorne et al. in view of U.S. Patent No. 4,897,303 to McCullough, Jr. et al.

ARGUMENTS

Claims 1-3 were improperly rejected as being unpatentable under 35 U.S.C. §103(a).

The instant invention, as recited in claim 1, is directed to a flexible fluid containment vessel for the transportation and/or containment of cargo comprising a fluid or fluidisable material, said vessel comprising, *inter alia*, a means for rendering the tubular structure buoyant comprising forming the fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant. Such an invention is neither disclosed, taught, enabled nor suggested in the cited documents. Further, the Hawthorne patent teaches away from such an invention.

1. The Cited References Do Not Teach the Claimed Invention

Contrary to the assertion of the Examiner, neither Hawthorne nor McCullough, either alone or in combination, teach, suggest, disclose or motivate a skilled artisan to practice the instantly claimed invention. More specifically, the combination of the cited documents do not teach, suggest or motivate a skilled artisan to practice the claimed flexible fluid containment vessel for the transportation and/or containment of cargo comprising a fluid or fluidisable material, said vessel comprising, *inter alia*, a means for rendering the tubular structure buoyant comprising forming the fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant.

2. There Is No Motivation to Combine the Cited References

The Examiner concludes that Hawthorne provides motivation to enhance the buoyancy of the fabric so that it could be used with fluidisable cargo that does not provide sufficient buoyancy on its own. The Examiner acknowledges that Hawthorne does not disclose a thermoset or thermoplastic coating that renders the fabric buoyant. In contrast, Hawthorne teaches that buoyancy of the vessel is created by the contents of the vessel. (Col. 1, lines 30-32).

But as the buoyancy in the apparatus described in Hawthorne is already provided for, one of ordinary skill in the art would not look to McCullough to provide additional buoyancy. Specifically, Hawthorne already teaches the use the vessel's contents to provide the necessary buoyancy. In fact, in contrast to the view of the Examiner, the disclosure of Hawthorne would steer a skilled artisan away from having at least one thermoplastic or thermoset coating that renders the fabric buoyant. It should be understood that the increase of buoyancy of a floating object is not always a desirable attribute as it can result in instability and undesirable towing or handling characteristics. Thus given the disclosure of Hawthorne, there would be no motivation for one skilled in the art to use the disclosure of McCullough and combine such teachings to incorporate at least one thermoplastic or thermoset coating that renders the fabric buoyant, and therewith the vessel more buoyant than that disclosed in Hawthorne. Consequently the disclosure of Hawthorne would not motivate a skilled artisan to practice the instantly claimed invention.

3. Hindsight is Impermissible

The Examiner has relied upon the knowledge of one skilled in the art as providing motivation for the combination of Hawthorne and McCullough. The Examiner is respectfully reminded that the requisite expectation of success under settled U.S. case law cannot be found in Applicants' specification and that an obviousness rejection based on hindsight is impermissible. It is submitted that as there is no indication of a desire to increase buoyancy in Hawthorne, the application of the teachings of McCullough can only be motivated by hindsight and should therefore be withdrawn.

4. Obvious to Try is Not the Standard For Obviousness

It is well-settled that “obvious to try” is not the standard upon which an obviousness rejection should be based. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1599-1600 (Fed. Cir. 1988). The Examiner alleges that increasing the buoyancy of the vessel described in Hawthorne would be obvious to one of skill in the art. But there is no suggestion in Hawthorne that such increased buoyancy is desirable. Accordingly, as “obvious to try” would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

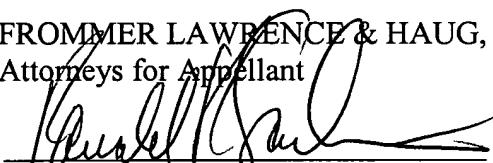
Accordingly, for at least the reasons described above, the documents cited by the Examiner fail to render claims 1-3 unpatentable under 35 U.S.C. §103(a). Therefore, the rejected claims should be allowed.

CONCLUSION

For the reasons discussed above, claims 1-3 are patentable. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1-3, and a reversal by the Board is solicited.

Respectfully submitted,

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APPENDIX

CLAIMS ON APPEAL

1. (Amended) A flexible fluid containment vessel for the transportation and/or containment of cargo comprising a fluid or fluidisable material, said vessel comprising:
an elongated flexible tubular structure comprised of fabric having a first side and a second side;
said tubular structure being impervious and having a front end and a rear end;
means for sealing said front end and said rear end;
means for filling and emptying said vessel of cargo; and
means for rendering said tubular structure buoyant comprising forming said fabric having at least one thermoplastic or thermoset coating that renders the fabric buoyant.
2. (Amended) The vessel in accordance with claim 1 wherein said fabric is woven and said first and second sides are formed by stitching points.
3. (Amended) The vessel in accordance with claim 1 wherein said fabric is formed out of yarns, and said at least one thermoplastic coating is subject to heat, pressure or both to cause it to flow and fill voids in said fabric.
4. (Amended) The vessel in accordance with claim 1 wherein a first thermoplastic coating is on said first side of the fabric and said second thermoplastic coating is on a second side of the fabric with said first thermoplastic coating being different from said second thermoplastic coating with said coatings being taken from the group consisting essentially of

urethane, polyester, polyamide, polyvinyl chloride, polyolefin or other suitable thermoplastic material.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None